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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,240	01/21/2004	Kia Silverbrook	WAL10US	2184

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER	
FERGUSON, MARISSA L	

ART UNIT	PAPER NUMBER
2854	

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/760,240	SILVERBROOK ET AL.	
	Examiner	Art Unit	
	Marissa L. Ferguson	2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-51* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 January 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/12/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Applicant has improperly submitted claims with duplicate claim numbers (i.e. two sets of claims 13,14 and 15). After the first set of claims 13,14 and 15, the claims have been numbered as claims 16-51, so that each claim has a unique claim number. In future communications applicant must refer to theses claims using the renumbered system.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,5,6,12,13-15,18,20-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5,6,10,11,13,14,18 and 23-51 of copending Application No. 10/760,256. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims include all the methods recited in the present invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 19-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 23-51 of copending Application No. 10/760,239. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims include all the methods recited in the present invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,4,12,14,17,18,20,22,33,39,40-43,46,47,49 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin (US Publication 2002/0171692).

Regarding claims 1,4,22,33,39,40-43,47,49 and 51,Martin teaches an on-demand printer (18) comprising a cabinet/frame (housing of printer 18 and refer to figure below) in which is located a media path (look at figure below) which extends from a media (27) loading area to a printhead (20) and from the printhead to a dispensing slot

(refer to figure below), the printer having one or more printer input devices (36,37) which communicate with a processor (38 and paragraph 0009) to capture data regarding one or more customer requirements including changing a pattern (paragraph 0010) , the data comprising at least a customer selected pattern (paragraph 0010, Lines 7-11), providing the franchisee with a collection of patterns in a digital storage medium (30) that can be read by the printer, enabling the franchisee to print a roll of wallpaper, onto a web of blank media, on demand, according to the selected pattern (Abstract), winding area (26 and refer to figure below) adapted to removably retain a core (core can be removed by reversing the process) and wind onto it, wallpaper produced by paper. With regards to obtaining a fee the consumer transaction is considered to be implicitly anticipated because it is known to exchange a fee for a product.

Regarding claims 12 and 14, Martin teaches providing media canister (24) to contain unprinted web and loading the canister with blank media (inherent to load the canister on the printer).

Regarding claims 17 and 18, Martin teaches a printhead (20) that is a full width color printhead that prints patterns accessible to the processor (38) and using a full width printhead (20) to print onto the web while it is motion (it is inherent that the printer is in motion).

Regarding claim 20, Martin teaches a franchisee that is instructed to operate the printer for a customer (Abstract and paragraph 0011).

Regarding claim 46, Martin teaches a printhead (20) being supplied with inks from ink supply (22) which is remote from the printhead and which is supplied through tubing (Figure 2).

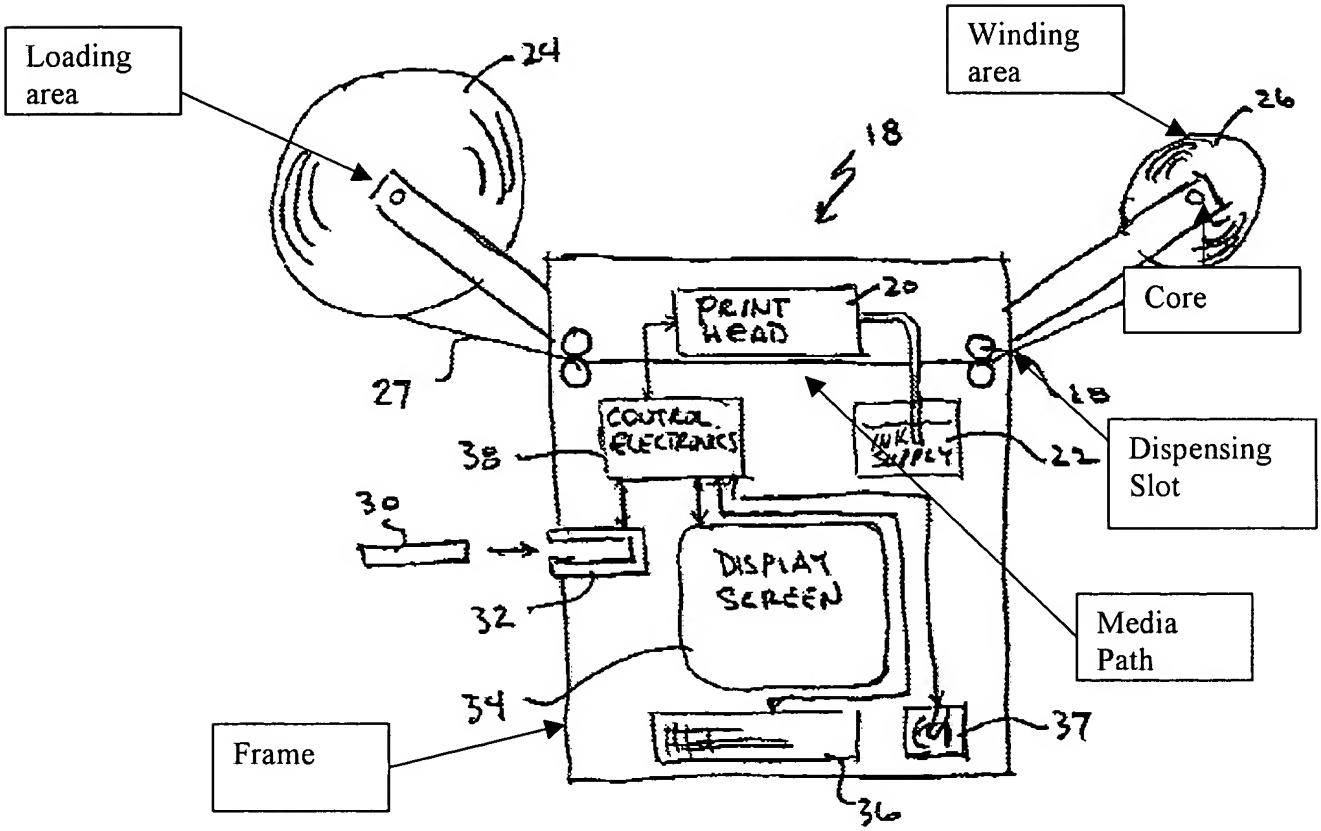

FIG. 2

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2,3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Fujii et al. (US Patent 6,715,423) and Kwasny 2002/01189900).

Martin teaches the claimed method with the exception of a printer that allows the customer to select a width and a printer that is used to slit a web. Fujii et al. teaches calculating an amount of wallpaper required by the customer based on room dimensions such as width supplied by customers (Figures 6,7 and 9). However, he does not disclose cutting/slitting a web. Kwasny teaches a slitting/cutting mechanism (16) for slitting a web. It would have been obvious to one of ordinary skill to modify the invention of Martin to include the width of wallpaper as per the customers requirements as taught by Fujii et al., since Fujji et al. teaches that it is advantageous to properly and accurately print out the wallpaper based on customer requirements and to also include a slitting/cutting mechanism as taught by Kwasny, since Kwasny improves the efficiency of cutting a web into multiple narrow sheets.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Goldstein (US 2002/0069078).

Martin teaches the claimed method including a display screen (paragraph 0058), however he does not teach a printer that acquires data from a touch-screen display which is also adapted to display the pattern to a customer of the franchisee. Goldstein teaches a step of using a touch-screen that operates with a wallpaper creation program

(Abstract, element 102 and paragraph 0058, lines 22-27). It would have been obvious to one of ordinary skill to modify the invention of Martin to replace the display screen thereof with the touch-screen display of Goldstein, since Goldstein teaches that it is advantageous to provide an easy and quicker method of entering data.

6. Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Gerber et al. (WO 03/064170).

Martin teaches the claimed method with the exception of an input device such as a scanner for capturing data. Gerber et al. teaches a method of printing wallpaper including an input device such as a scanner (24) for scanning designs and patterns that are used in wallpaper design (page 3, lines 18-20 and lines, 31-33). It would have been obvious to one of ordinary skill to modify the invention of Martin to include a scanner as taught by Gerber et al., since Gerber et al. teaches that it is advantageous for easily inputting designs that are selected by the operator.

7. Claims 7,8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Krinsky (US Patent 6,354,212).

Martin teaches the claimed method with the exception of providing a variety of blank media types so that they may used in the printer, providing one or more collections of printed swatches which correspond to patterns that the printer is able to print on demand and providing new patterns from time to time. Krinsky teaches a method of preparing customized wallpaper panels (1-4 and 3-6) that are used in the printer, a collection of samples (Column 4, Lines 11-15) and the customers have the ability to personalize or customize their own designs (Column 2, Lines 38-67 and

Column 3, Lines 1-22). It would have been obvious to one of ordinary skill to modify the invention of Martin to include a plurality of blank media types and a collection of samples as taught by Krinsky, since Krinsky teaches that it is advantageous to provide personalized custom wallpaper panels for aesthetically pleasing purposes.

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Krinsky (US Patent 6,354,212) as applied to claims 1 and 8 above, further in view of Lapointe et al. (US 5,056,142)

Martin and Krinsky both teach the invention claimed with the exception of swatches that are assigned a printed symbol. Lapointe et al. teaches a device that has a sample book of samples that each contain symbols (Column 1, Lines 53-60 and column 4, Lines 59-68). It would have been obvious to one of ordinary skill to modify the invention of Martin to include a samples that contain symbols as taught by Lapointe et al., since Lapointe et al. provides a easier method of identifying a particular sample in a quick, efficient amount of time.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Schoendienst et al. (US Patent 5,302,037).

Martin teaches the claimed method with the exception of providing a motor in the printer to advance the unprinted web into the path by automatically threading the media through the printer. Schoendienst et al. teaches using a motor (M) for advancing a web and it should be obvious that the web will automatically thread. It would have been obvious to one of ordinary skill to modify the invention of Martin to include a motor that automatically threads a web as taught by Schoendienst et al., since Schoendienst et al.

teaches that it advantageous to provide the necessary power to accurately advance the web.

10. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Bilek (US Patent 4,322,044).

Martin teaches the claimed method including loading a disposable media tote (26) into a winding area adjacent to the dispensing slot and winding a printed roll of wallpaper onto a core inside the tote (refer to figure below), however he does not explicitly disclose severing the printed roll on the core from the web. Bilek teaches a printer with a take-up roll core (39) and a paper tear bar (34) for severing the print media web (19) from the supply roll (17 and column 3, Lines 21-22). It would have been obvious to one of ordinary skill to modify the invention of Martin to include a tear bar for severing as taught by Bilek, since Bilek teaches that it is advantageous to easily separate the media web from the supply roll.

11. Claims 19,38 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Sandhoo (DE 29908649).

Martin teaches the claimed method with the exception of drying a web after it is printed on but before it is dispensed by the printer. Sandhoo teaches a dryer (no element number is provided) located between the printing area (4) and the winding area (6) for drying the printed web (8). It would have been obvious to one of ordinary skill to modify the invention of Martin to include a dryer as taught by Sandhoo, since Sandhoo provides a dryer for quickly and efficiently drying a printed web to prevent smudging.

12. Claims 21, 35,45 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Harris et al. (US Patent 5,161,685).

Martin teaches the claimed method with the exception of a tote for holding cores which cooperate with a winding area and a disposable exterior in which is formed a main access flap and a pair of core access openings and the tote having an interior in which is located a disposable core which is aligned with the access openings and exposing a moulded coupling, attached to each end core, at least one core of the couplings being a driven coupling and adapted to engage a driving spindle that rotates a core .

Harris et al. teaches a tote for holding a core with a winding area including a disposable exterior (42 and also note that Taylor et al. is silent of a material of exterior that is disposable, however anything can be considered disposable) with a main access flap (46) and a pair of core access openings (44b,46b) that are comprised with bearing surfaces (column 5, lines 13-19) and the tote having an interior in which is located a disposable core (any object can be disposable) which is aligned with the access openings (Figure 5), has molded hubs (48) for supporting the core,c and an external coupling (50) that could be used to engage a rotating winding spindle.

It would have been obvious to one of ordinary skill to modify the invention of Martin to include a tote as taught by Taylor et al. for the purpose of providing an easy method of transporting, protecting and dispensing a roll of media.

13. Claims 23-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692).

Martin teaches the claimed method including using a printhead (20), however he does not explicitly a wide selection of desire rates at which a printhead prints on a web/medium or the selection of the number of nozzles or number of ink drops for each of the printheads. However, it would have been obvious through routine experimentation to test wide selection of printheads in order to get the best possible print quality.

14. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Nagel (US Patent 5,362,008).

Martin teaches the claimed invention with the exception of a case having two halves, hinged together, an area between the two halves, when closed defining a media slot and the case having internally and adjacent slot, a pair of rollers, at least one roller being a driven roller which is supported at each end, by the case. Nagel teaches a media cartridge including a case with two halves (20a,21 and Figure 5), a media supply slot (23) located between the two halves when they are closed, a pair of rollers (39,40) inside the case and adjacent the supply slot (23) and a driven roller (40) that can be driven by an external motor (Figure 5). It would have been obvious to one of ordinary skill to modify the invention of Martin to replace the case thereof with a hinged case as taught by Nagel, since Nagel teaches that it is advantageous to provide a case that is easy to open.

15. Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Nielson et al. (US Patent 4,885,964).

Martin teaches the claimed invention with the exception of a chassis having end plates, slitter shafts and slitting mechanism. Nielson et al. discloses a slitting mechanism including a chassis having end plates and transverse portion (shown in Figure 1), a slitting shaft (12) having a plurality of slitters (13) with cutting edges (Figure 2). It would have been obvious to one of ordinary skill to modify the invention of Martin to replace the case thereof with a chassis with end plates and a slitting mechanism for providing a stable mechanism for effectively cutting a web.

16. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Schoendienst et al. (US Patent 5,302,037) and Yada (JP 2003/063700).

Martin teaches the claimed method with the exception of providing a motor in the printer to advance the unprinted web into the path by automatically threading the media through the printer and pilot guide Schoendienst et al. teaches using a motor (M) for advancing a web and it should be obvious that the web will automatically thread. However, Schoendienst et al. does not teach a pilot guide. Yada teaches a pilot guide (4220) for print media (100b, Figure 15). It would have been obvious to one of ordinary skill to modify the invention of Martin to include a motor that automatically threads a web as taught by Schoendienst et al., since Schoendienst et al. teaches that it advantageous

to provide the necessary power to accurately advance the web and to include a pilot guide for guiding the print media in a desired direction so that it does not jam and disrupt the printing process.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa L. Ferguson whose telephone number is (571) 272-2163. The examiner can normally be reached on (M-T) 6:30am-4:00pm and every other (F) 7:30am-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marissa L Ferguson
Examiner
Art Unit 2854

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Daniel J. Colilla
Primary Examiner
Art Unit 2854